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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,422	12/17/2001	Oscar A. Zuniga	10016478-1	3354

7590 12/09/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

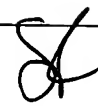
QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/024,422	Applicant(s) ZUNIGA ET AL. 	
	Examiner Adam M Queler	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Application received 12/17/2001.
2. Claims 1-20 are pending in the case. Claims 1-7 are withdrawn. Claims 8 and 14 are pending independent claims.

### ***Election/Restrictions***

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-7, drawn to converting two media into a presentation, classified in class 715, subclass 500.1.
  - II. Claims 8-20, drawn to displaying annotations in a presentation, classified in class 715, subclass 512.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because that manner in which in the media is combined is not essential to its separation.

The subcombination has separate utility such as use in OCR device.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with John Moran on 11/30/2004 a provisional election was made with traverse to prosecute the invention of claims 8-13. Upon closer examination by the Examiner, it was determined that claims 14-20 were not patentably distinct from claims 8-13 as the Examiner had indicated. Therefore, the provisional election will be considered to be made with traverse to prosecute the invention of claims Group II, claims 8-20, which encompasses the original election made by Applicant. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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**10. Claims 8-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Quentin et al. (US005208745A, patented 5/4/1993).**

**Regarding independent claim(s) 8,** Quentin teaches receiving a multimedia presentation (col. 4, ll. 48-54). Quentin teaches separating the media (col. 5, ll. 62-65).

**Regarding dependent claim(s) 9,** Quentin teaches displaying media (col. 12, ll. 41-43).

**Regarding dependent claim(s) 10,** Quentin teaches printing media (col. 5, line 52).

**Regarding dependent claim(s) 11,** Quentin teaches generating sound from media (col. 5, line 52).

**Regarding dependent claim(s) 12,** Quentin teaches the audio is used to help a user with the first media. This is determined to be an annotation.

**Regarding dependent claim(s) 13,** Quentin teaches synchronizing the media (col. 4, line 67 – col. 5, line 6).

**Regarding independent claim(s) 14,** Quentin teaches transducers for formatting the two media (col. 4, ll. 41-47). Quentin teaches receiving a multimedia presentation (col. 4, ll. 48-54). Quentin teaches separating the media (col. 5, ll. 62-65). Quentin teaches the media are for network delivery (col. 23, line 50 – col. 24, line 24).

**Regarding dependent claim(s) 15,** Quentin teaches an interface (col. 2, ll. 24-25).

**Regarding dependent claim(s) 16,** Quentin teaches sending to a network destination (col. 23, line 50 – col. 24, line 24).

**Regarding dependent claim(s) 17,** Quentin teaches receiving at network destination (col. 23, line 50 – col. 24, line 24).

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**Regarding dependent claim(s) 18**, Quentin teaches synchronizing the media (col. 4, line 67 – col. 5, line 6).

**Regarding dependent claim(s) 19**, Quentin teaches an audio transducer (col. 4, ll. 41-43).

**Regarding dependent claim(s) 20**, Quentin teaches a screen for display, or imaging transducer (col. 4, ll. 15-16).

### *Conclusion*

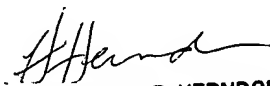
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

  
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